

Application No. 10/089,854  
Amendment dated January 23, 2006  
Reply to Final Office Action of August 22, 2005

Docket No. 0887-4151US1

### **REMARKS**

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments to the claims and following remarks.

#### **Status of the Claims**

Claims 1-58 are pending in this application. Claims 1, 13, 20, 26, 38, 43, 47 and 49-53 are independent. All of the pending claims stand rejected. By this Amendment, independent claims 1, 13, 43, 49 and 52 are amended. No new matter has been added by this Amendment.

#### **Rejection under 35 U.S.C. §102**

Claims 1-4, 13-15, 18, 20, 26-34, 38-41, 43-45 and 47-58 have been rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 5,793,969 to Kamentsky et al. ("Kamentsky").

The Examiner indicated, *inter alia*, that Kamentsky's Figs. 2 and 3 each shows a first image magnified at 20x and a second image magnified at 40x. The Examiner further cites col. 1, line 66 - col. 2, line 8; col. 3, lines 4-24; and col. 7, lines 56-67 of Kamentsky as disclosing "a first image including an entire specimen" of the present invention.

Kamentsky discloses a network system for review and analysis of computer encoded microscope slides and specimens which were originally computer encoded from a microscope during an initial examination. Kamentsky's system enables a senior supervisor to review an initial examination performed by a less experienced viewer thereby checking how the initial viewer examined the glass slide. To this end, Kamentsky's system records the manner in which a first viewer examines a microscopic cytology specimen by recording the locations of the viewing area by the first viewer, and the sequence and timing of how the first viewer examines

Application No. 10/089,854  
Amendment dated January 23, 2006  
Reply to Final Office Action of August 22, 2005

Docket No. 0887-4151US1

the slide. These information are marked on the slide for subsequent viewing by other viewers (e.g., a senior supervisor).

In Kamenstky, however, there is no background image that covers an entire tissue section is captured and stored. Accordingly, the majority of the histology (including cells and other tissue components) is missing from the recorded data. Therefore, the recorded data in Kamentsky would not be able to serve as a package of information to convey the details of the slide independently. As a result, when the senior supervisor reviews the specimen, it is necessary to put the original glass slide on the microscopic stage again, i.e., the recorded data only serve as a guide superimposed on top of the real glass slide to guide the senior supervisor.

In contrast, the present invention is directed to a "virtual telemicroscope" in which a remote user (i.e., a pathologist) connected to the virtual microscope system of the present invention with a network (e.g., an Internet) can download the prepared information regarding the specimen and conduct a diagnosis of the species as if he is manipulating a light microscope without actually placing the original slide on the microscopic stage. To this end, the present invention captures an entire image of a specimen as a first image, then captures a secondary image corresponding to a selected area of the first image having a higher magnification. These images are inter-related (i.e., mapping) and stored in a computer medium.

Again, there is nothing in Kamentsky including the cited portions by the Examiner that teaches capturing an entire specimen as a first image and a secondary image corresponding to a selected area of the first image with a higher magnification than the first image, as specifically required by the present invention. For example, Fig. 2 of Kamentsky shows a report form for patient name "BURTON" while Fig. 3 shows a report form for patient name "JAMES", i.e.,

Application No. 10/089,854  
Amendment dated January 23, 2006  
Reply to Final Office Action of August 22, 2005

Docket No. 0887-4151US1

these are figures for two different patients. Additionally, a portion of Kamentsky mentions that selected areas of images are captured and stored. However, these images are for the purpose of comparison with known cell images stored in database, i.e., the captured images in Kamentsky's system would not be able to form a virtual slide to convey information of the entire slide.

Independent claims 1, 13, 43, 49 and 52 have been amended to further clarify this aspect of the invention (i.e., capturing an entire specimen as a first image). Other independent claims (i.e., claims 20, 26, 38, 43, 47, 48, 50, 51 and 53) recite this aspect as they are.

Accordingly, each of independent claims 1, 13, 20, 26, 38, 43 and 47-53 as amended is believed neither anticipated by nor rendered obvious in view of Kamentsky for at least the reasons discussed above.

Reconsideration and withdrawal of the rejections of claims 1, 13, 20, 26, 38, 43 and 47-53 under 35 U.S.C. §102 (b) is respectfully requested.

Applicant has not individually addressed the rejections of the dependent claims because Applicant submits that the independent claims from which they respectively depend are in condition for allowance as set forth above. Applicant however reserves the right to address such rejections of the dependent claims should such be necessary.

Applicant believes that the application is in condition for allowance and such action is respectfully requested.

Application No. 10/089,854  
Amendment dated January 23, 2006  
Reply to Final Office Action of August 22, 2005

Docket No. 0887-4151US1

**AUTHORIZATION**

A petition for a two-month extension of time along with the associated fee is enclosed, extending the date for responding until January 23, 2006 (as January 22, 2006 falls on Sunday). Should an additional extension of time be required to render this paper timely filed, such extension is hereby petitioned and the Commissioner is authorized to charge any other fees necessitated by this Amendment, or credit any overpayment to our Deposit Account No. 13-4500 (Order No. 0887-4151US1). A DUPLICATE COPY OF THIS SHEET IS ENCLOSED. An early and favorable examination on the merits is respectfully requested.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: January 23, 2006

By: 

Sungho Hong  
Registration No. 54,571

**Correspondence Address:**

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 (Telephone)  
(212) 415-8701 (Facsimile)

Application No. 10/089,854  
Amendment dated January 23, 2006  
Reply to Final Office Action of August 22, 2005

Docket No. 0887-4151US1

**AUTHORIZATION**

A petition for a two-month extension of time along with the associated fee is enclosed, extending the date for responding until January 23, 2006 (as January 22, 2006 falls on Sunday). Should an additional extension of time be required to render this paper timely filed, such extension is hereby petitioned and the Commissioner is authorized to charge any other fees necessitated by this Amendment, or credit any overpayment to our Deposit Account No. 13-4500 (Order No. 0887-4151US1). A DUPLICATE COPY OF THIS SHEET IS ENCLOSED. An early and favorable examination on the merits is respectfully requested.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: January 23, 2006

By: 

Sungho Hong  
Registration No. 54,571

**Correspondence Address:**

MORGAN & FINNEGAN, L.L.P.  
3 World Financial Center  
New York, NY 10281-2101  
(212) 415-8700 (Telephone)  
(212) 415-8701 (Facsimile)